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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,446	09/26/2000	Lawrence Bergman	YOR9-2000-0504-US1	3531
35526	7590	01/28/2010		
DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			EXAMINER WEISBERGER, RICHARD C	
			ART UNIT	PAPER NUMBER
			3693	
			NOTIFICATION DATE	DELIVERY MODE
			01/28/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[ptonotifs@yeciipaw.com](mailto:ptonotifs@yeciipaw.com)

# Office Action Summary

**Application No.**

09/670,446

**Applicant(s)**

BERGMAN ET AL.

**Examiner**

Richard C. Weisberger

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Preliminary Matters***

The examiner for this application has changed. Please indicate Examiner Richard Weisberger as the examiner of record in all future correspondences.

In view of the Appeal Brief filed on 3/15/04, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

***Claim Rejections - 35 USC § 112***

Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The algorithm for ranking the bids critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

See page 12, line 17 of the specification where rule sets are discussed and scores are said to be determined, yet no algorithm is presented.

Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method and system that determines the criteria set forth in the user profile prior to apportioning the presentation resources, it does not reasonably provide enablement for delivering the ad, apportioning the presentation resources, without said data. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims, the limitation ranking the bids is vague and indefinite as the bids. It is not clear if the bids for each benefit are ranked or if the bids are ranked across benefit categories. If it is the latter, it not clear how this is achieved.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Merrimen et al, US Patent 5948061 (All previous rejections have been withdrawn.)

The reference (columns 1-4) teaches the receipt of advertisements stored in the ad server (col.4, line 20+) and the examiner interprets the content of the data base (the text of the ads) to reads on the bid benefit claimed and thus the reference teaches of receiving bids for the presentation resources of the digital device from a plurality of product/service providers, wherein each bid identifies a benefit (, associated with a product/service of a given product/service provider, offered to a user of the digital device;

the reference also teaches of selecting an ad via a matching algorithm and thus reads on ranking the bids based on the benefit offered to the user (col. 1, line 52);

the reference teaches of positioning the ad (col. 1) on the views web page and thus apportioning the presentation resources of the digital device in accordance with the ranking of the bids; and presenting information for at least one of the plurality of product/service providers using the apportioned presentation resources.

As for claim 5, the ad content reads one or more of product/service identification information and an incentive to buyers of a product/service.

As for claim 7 the examiner interprets the content of the ad to read in a value for the incentive and thus the reference teaches the method of claim 1 wherein each bid includes one or more

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of a product/service code, a product/service cost ranking, an incentive type code, and a value for the incentive.

As for claim 8, the reference teaches of matching the ads and thus teaches the method of claim 1, wherein ranking the bids based on the benefit offered to the user includes ranking the bids based on one or more rule sets.

As for claims 9, the reference teaches of placing a single banner as and thus teaches the method of claim 1, wherein the digital device includes a display, wherein the presentation resources include display space on the display, and wherein apportioning the presentation resources of the digital device in accordance with the ranking of the bids includes allocating a portion of the display space on the digital device in accordance with the ranking of the bids.

As for claim 10, the reference teaches of placing the ad for a finite period of time and thus teaches the the method of claim 1, wherein the presentation resources include presentation time and wherein apportioning the presentation resources of the digital device in accordance with the ranking of the bids includes allocating presentation time on the digital device in accordance with the ranking of the bids.

As for claim 11, the reference teaches of placing the ad and thus teaches wherein the digital device includes a display, wherein the presentation resources include display space on the display, and wherein apportioning the presentation resources of the digital device in accordance with the ranking of the bids includes allocating a display position within the display space in accordance with the ranking of the bids.

As for claim 2, the reference teaches of a using information stored on a cookie in the user's device and thus teaches of transmitting a request for information from at least one product/service provider.

The reference teaches of matching the appropriate ad to the information with the cookie and this inherently teaches of filtering out unwanted information from product/service providers (the non-selected

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wanted ads);

As discussed in the claims directed to claim 1, and those dependent thereon, the reference teaches of receiving the information from the at least one product/service provider, the information identifying a benefit, associated with a product/service of the at least one product/service provider, offered to a user of the digital device; ranking the information based on the benefit offered to the user; and presenting the information via the digital device in accordance with the ranking of the information such that higher ranking information is presented more prominently than lower ranking information.

The reference teaches of using the information on the user's cookie and thus teaches the method of claim 2, wherein filtering out unwanted information from product/service providers includes determining if the information from the product/service providers meets criteria in a user profile.

The examiner contends that the information in the cookie reads on the method of claim 2, wherein filtering out unwanted information from product/service providers includes receiving a user selection of unwanted product/service provider groups.

As for claim 12, 13, and 14 and 15 the examiner contends that the when broadly interpreted the user's computer reads on a sensor.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 16-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman  
(Previous rejections of record have been withdrawn.)

As for claim 6, it would have been obvious for one skilled in the art to have matched the ad based on the proximity of the user to, for example, the a retail store advertiser, as motivated by the need to target the ad to likely shoppers and thus it renders obvious the benefit to the user is at least one of a discount, a rebate, free shipping and handling, free accessories, proximity to the user, and time urgency.

As to claims 16-45, as these claims correspond to the apparatus and computer readable medium of the method claims, it would have been obvious for one skilled in the art at the time to have built the apparatus and recorded the computer readable medium as motivated by the need to apply the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard C. Weisberger whose telephone number is 571 272 6753. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571 272 6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richard C Weisberger  
Primary Examiner  
Art Unit 3693

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Primary Examiner, Art Unit 3693